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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,239	08/20/2001	Paul Brand	P01,0178	3292

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EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3762

DATE MAILED: 09/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,239

Applicant(s)

BRAND ET AL.

Examiner

Frances P. Oropeza

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/20/01 (I. Filing) & 8/20/03 (P. Amend).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,12 and 17 is/are rejected.
- 7) ☒ Claim(s) 11 and 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 August 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, the term metallic tubular sleeve is unclear because the Examiner is unable to find this term in the specification. For purposes of this examination, the Examiner is reading this term to be the metallic plug (28) or the contact ring (27).

In claim 17, the term a peripheral groove (31) is unclear because the Examiner is unable to find this term in the specification. For purposes of this examination, the Examiner is reading this term to be the end part (17).

Renumbered claim 17 is unclear because it depends upon itself.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The applied reference appears to have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

3. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Johansson et al. (US 6327502). Johansson et al. disclose an implantable stimulator including a contact plug/ lead (30), a tubular member (34), a plurality of interior elements (figure 5), and insulating plug (42, 35, 36), an exterior contact surface (32, 33, 38, 39), an interior contact surface (38, 39, 41, 42), and a metal plug/ contact ring (38, 39) (figure 5, col. 2 @ 17-32; col. 4 @ 5-37, col. 6 @ 5-13).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint Inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Applicant is advised of the obligation under 37 CFR 1.56 to point out the Inventor and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US 5383913) in view of Hawkins et al. (US 6029089).

Schiff discloses a metal sleeve (48), read as metallic tubular member, disposed in a housing (30), containing a plurality of interior components (figure 3) to make mechanical and electrical contact with the contact plug (18) (figures 1, 2, 3, and 7). The tubular member is closed by way of a plug (35). The insulating plug (47) has interior elements mounted therein.

As discussed in the previous paragraph of this action, Schiff discloses the claimed invention except the housing being metallic and the tubes ends being bonded or welded to the housing

Hawkins et al. teach implantable device component assembly using a metallic housing with the barrel welded or bonded to the housing for the purpose of securing the barrel assembly in the device. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used metallic housing and bonding or welding the barrel to the housing in the Schiff system in order to simplify the device housing by replacing the cast epoxy connector with a metallic housing and using a weld/ bond to provide firm attachment of the barrel so the device is simplified and hermetically sealed and protected from bodily fluids (figure 3; col. 2 @ 26-47; col. 5 @ 35-45).

Allowable Subject Matter

6. Claims 11 and 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 12 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Drawings

8. The drawings are objected to because the Examiner is unable to find:

- The reference numeral "5" of figure 1 in the specification, and
- The reference numeral "122" of figure 6 in the specification.

Correction is required.

Specification

9. The substitute specification, filed 8/20/01 has been entered into the record.

10. The disclosure is objected to because the substitute specification contains numerous typographical errors. Review and correction, as needed, of the specification and drawings in suggested. The Examiner found the following errors:

- On page 6, line 23, "outer" should be --outer--, and "free 15 from" should be --free from-- ,
- On page 6, line 26, "plug 20 28*" should be --plug 28*--,
- On page 8, line 12, "ring 70 10" should be --ring 70--,
- On page 8, line 14, "hollow" should be --hollow--,

- On page 8, lines 18-19, "112-116" should be --112, 113, 114 and 116--,
- On page 8, line 27, "111" should be --111--,
- On page 8, line 29, "surface "112" should be --surface 118--,
- On page 9, line 20, "s1illing" should be --slipping--,
- On page 10, line 17, "124, :L25" should be --124, 125--, and
- On page 11, line 29, "5mm,," should be --5mm,--.

Appropriate correction is required.

Claim Numbering

11. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 18 has been renumbered to claim 17, as there is no claim 17.

Information Disclosure Statement

12. The reference EP 0 261 582 A1 included in the information disclosure statement filed 4/24/01 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The signed information disclosure statement has been placed in the application file, but the EP 0261 582 reference referred to therein has been lined through as it has not been considered.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

FPO
9-17-03

Angela D. Sykes

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